

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SERGE BAX, PAOLO CIOCCA
and EDWARD L. MUMPOWER

Appeal No. 1997-3520
Application No. 08/357,487

ON BRIEF

Before KIMLIN, PAK and LIEBERMAN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7, 13 and 14. Claims 8-12, the other claims remaining in the present application, stand withdrawn from consideration as

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being directed to a non-elected invention. Claim 1 is
illustrative:

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1. A heat-shrinkable film comprising:
 - a) a core layer comprising an ethylene-vinyl alcohol copolymer;
 - b) two outer layers comprising a blend of ethylene-vinyl acetate copolymer and ethylene-"-olefin copolymer; and
 - c) two adhesive layers,
wherein said film has
 - i) a free shrink of at least 40% in both directions at 120EC and
 - ii) a maximum shrink force in the transverse direction, throughout its range of shrink temperatures, not exceeding 0.5 N/cm.

The examiner relies upon the following references as evidence of obviousness:

Bornstein et al. (Bornstein)	4,064,296	Dec. 20, 1977
Newsome (Newsome '960)	4,457,960	Jul. 3, 1984
Newsome (Newsome '897) (European patent application)	0,092,897	Feb. 11, 1983

Appellants' claimed invention is directed to a heat-shrinkable film comprising a copolymeric core layer, and two adhesive layers bonding the core layer to two outer layers of a blend of copolymers. The film has a free shrink of at least 40% in both directions at 120EC and a maximum shrink force in the transverse direction that does not exceed 0.5 N/cm.

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According to appellants, heat-shrinkable films having a
maximum shrink force

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in excess of 0.5 N/cm can lead to a severe distortion of a food-carrying tray and "even render the package unfit for commercial use" (page 7 of Brief). Appellants' heat-shrinkable film possessing the claimed maximum shrink force "is obtained by submitting the film, after orientation, to a subsequent heat treatment" (page 8 of Brief).

Appealed claims 1-7, 13 and 14 stand rejected under 35 U.S.C. § 112, second paragraph. The appealed claims also stand rejected under 35 U.S.C. § 103 as being unpatentable over Newsome '897 or Newsome '960 in view of Bornstein.¹

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain either of the examiner's rejections.

We consider first the examiner's rejection of the appealed claims under 35 U.S.C. § 112, second paragraph. According to the examiner, claim 1 is indefinite "since the relative position of the adhesive and outer layers are not unambiguously set forth and since there is no antecedent basis for 'transverse direction' or 'both directions'" (page 3 of

¹ Newsome '897 is equivalent in disclosure to Newsome '960.

Answer). However, we fully concur with appellants that when the criticized claim language is read in light of the present specification, as it must be, one of ordinary skill in the art would readily understand that "one adhesive layer is disposed between, and adheres, the barrier core layer to an outermost layer, and the other adhesive layer is disposed between, and adheres, the barrier core layer to another outermost layer" (page 11 of Brief). Likewise, the examiner has not set forth any compelling line of reasoning which establishes that one of ordinary skill in the art would not understand the claim language "both directions" to refer to the longitudinal and transverse directions of the film.

We now turn to the examiner's rejection under 35 U.S.C. § 103. The examiner acknowledges that the applied references, particularly the primary references of Newsome, are silent regarding the maximum shrink force of the disclosed heat-shrinkable film. Notwithstanding this silence, the examiner concludes that "the film of Newsome would inherently meet the criterion of 0.5 N/cm since depending upon test sample dimensions or thickness of the Newsome film it would meet the limitation as now claimed" (page 5 of Answer). However, the

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fatal flaw in the examiner's rejection is that the examiner fails to lend factual support to the ultimate conclusion of inherency. It is well settled that a determination of inherency cannot be established by probabilities or possibilities, but that it is incumbent upon the examiner to establish the inevitability of the inherency which is propounded. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); In re Wilding, 535 F.2d 631, 635-36, 190 USPQ 59, 63-64 (CCPA 1976). The examiner's reference to the dimensions or thickness of Newsome's test samples is bare speculation.

In some instances it is appropriate for an examiner to reject a claimed article on the principle of inherency when it can be demonstrated that there is a substantial correspondence between the methods of making the claimed article and the article of the prior art. However, in the present case, the examiner has not attempted to draw any such correspondence between appellants' method of making the claimed heat-shrinkable film and the method disclosed by Newsome. Significantly, appellants disclose that the claimed film is prepared by heating the film obtained by the known extrusion

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and orientation processes to a temperature in the range of about 70°C to about 100°C. On the other hand, Newsome discloses no such processing after orientation. Hence, there is no factual basis on this record for concluding that the films of Newsome have the maximum shrink force recited in the appealed claims.

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In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
PAUL LIEBERMAN)	
Administrative Patent Judge)	

ECK:clm

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